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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Application of Brendan F. Murphy

Art Unit 1645

Serial No. 09/805,337

Filed March 13, 2001

Confirmation No. 1925

For NOVEL FACTOR-H RELATED PROTEIN 5 AND ANTIBODIES THERETO

Examiner: Unknown

May 28, 2003

**RESPONSE TO RESTRICTION REQUIREMENT**

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action of April 28, 2003, in which an election as between the following groups of claims for prosecution on the merits was requested: Group I (claims 1-2) drawn to a factor H-related protein 5; Group II (claims 3-11) directed toward a polynucleotide encoding a factor H-related protein 5; Group III (claims 12-13, 15-21, and 23-28) drawn to a polyclonal antibody to a factor H-related protein 5; Group IV (claims 12, 14-20, and 22-28) directed to a monoclonal antibody to a factor H-related protein 5; Group V (claims 29-30) drawn to a method for detection of C5b-9 using a polyclonal antibody to a factor H-related protein 5; and Group VI (29-30) directed toward a method for detection of C5b-9 using a monoclonal antibody to a factor H-related protein 5.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made **without serious burden**, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."<sup>1</sup>

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<sup>1</sup> MPEP § 803 (emphasis added).

In this case, restriction is not proper. The claims of Group I, Group II, Group III, Group IV, Group V and Group VI each have a common element, **a factor H-related protein 5**. Any search of the prior art and examination involving Group I claims, therefore, will necessarily co-extend with the search and examination of Group II, Group III, Group IV, Group V and Group VI claims. Moreover, the prior art regarding factor H-related protein 5 is sufficiently sparse to allow the examination of these claims without undue burden. Thus, as the examination of the entire application may be made without serious burden, the claims of Groups I, II, III, IV, V, and VI should be examined together in accordance with MPEP § 803.

In the alternative, and at the very least, the claims of Groups I and II should be rejoined and examined together. In support of its restriction of Group I and Group II, the Office states that the protein of Group I and the nucleic acid of Group II are "physically and functionally distinct entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis. Further, the DNA may be used for processes other than the production of the protein."<sup>2</sup> While these assertions each may be correct, they do not provide a proper basis for a restriction requirement. As detailed above, the claims of Group I are directed toward **a factor H-related protein 5** and the claims of Group II are directed toward a nucleic acid that encodes the protein of the Group I claims (i.e. **a factor H-related protein 5**). No showing has been made that a search and examination of the prior art for a factor H-related protein 5 and a nucleic acid encoding a factor H-related protein 5 would be an undue burden. Without this showing, the Office has not established a *prima facie* case under 35 U.S.C. §121. As such, Applicant respectfully requests rejoinder of the Group I and Group II claims.

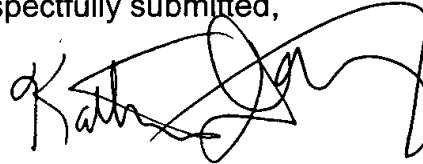
Applicant, subject to the foregoing traverse, hereby elects to prosecute the claims of Group I, claims 1-2, drawn to a factor H-related protein 5 or a fragment thereof.

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<sup>2</sup>See Paper 12 at page 2-3.

Applicant reserves the right to file divisional applications directed to the subject matter of the non-elected claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kathryn J. Doty', with a large, stylized flourish extending from the end of the signature.

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